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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,985	07/09/2001	Kenneth L. Riley	GJH-0006	4473

7590 08/26/2003  
Gerard J Hughes  
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EXAMINER

ARNOLD JR, JAMES

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/869,985

Applicant(s)

RILEY ET AL.

Examiner

James Arnold, Jr.

Art Unit

1764

Peri d f r Reply - The MAILING DATE of this communicati n appears on th c ver sheet with the c rrespondenc address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

The finality of the rejection in Paper No. 8 is withdrawn and new grounds of rejection are set forth in this Office Action.

#### *Double Patenting*

Claim 5 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 12.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 12 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 5.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP

§ 706.03(k).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-8, and 10-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,162,350. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims disclose a hydroprocessing method utilizing a bulk metal catalyst comprising molybdenum, tungsten, oxygen, and nickel having an X-ray diffraction pattern with crystalline peaks at  $d=2.53$  Angstroms and  $d=1.70$  Angstroms.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize cobalt in lieu of nickel as a component of the bulk metal catalyst because both cobalt and nickel are both Group VIII metals and would be expected to exhibit similar properties.

Claims 1-3, 5-8, and 10-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 09/869,983. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims disclose a hydroprocessing method utilizing a bulk metal catalyst comprising molybdenum, tungsten, oxygen, and nickel having an X-ray diffraction pattern with crystalline peaks at  $d=2.53$  Angstroms and  $d=1.70$  Angstroms.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a process wherein the molar ratio of  $c:d$  is preferably  $>0.01/1$ , more preferably  $>0.1/1$ , still more preferably  $1/10$  to  $10/1$ , still more preferably  $1/3$  to  $3/1$ , most preferably  $1/3$  to  $3/1$ , most preferably substantially equimolar amounts of Mo and W, e.g.,  $2/3$  to  $3/2$ ; and  $z=[2b + 6(c+d)]/2$  because the present set of claims discloses a  $c:d$  ratio of  $1/10$  to  $10/1$

and it would be appropriate to adjust the ratio to create a bulk multimetallic catalyst with unique crystalline peaks. It would have been obvious to one having ordinary skill in the art at the time the invention was made to hydrocrack the effluent from the hydrotreated feedstock because this allows for greater sulfur reduction.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 5-8, and 10-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 09/869,988. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims disclose a hydroprocessing method utilizing a bulk metal catalyst comprising molybdenum, tungsten, oxygen, and nickel having an X-ray diffraction pattern with crystalline peaks at  $d=2.53$  Angstroms and  $d=1.70$  Angstroms.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize two or more catalyst beds in a single reaction stage because it allows for greater sulfur removal.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Response to Arguments***

Applicant's arguments have been fully considered and are deemed persuasive. Consequently, the rejections set forth in Paper 8 have been withdrawn.

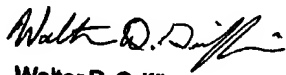
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Arnold, Jr. whose telephone number is 703-305-5308. The examiner can normally be reached on Monday-Thursday 8:30 AM-6:00 PM; Fridays from 8:30 AM-5:00 PM with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 703-308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

ja  
August 18, 2003

  
Walter D. Griffin  
Primary Examiner